

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Hubbard, et al.	
Application No.: 10/605,862	Group Art Unit: 1743
Filed: 10/31/2003	Examiner: Lyle Alexander
Title: Tagging Material for Polymers, Methods, and Articles Made Thereby	Confirmation No: 2861
Attorney Docket No.: GEPL.P-092	
Customer No.: 43247	

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PETITION TO THE DIRECTOR UNDER 37 CFR 1.181

FOR REVIEW OF RESTRICTION REQUIREMENT

Dear Sir:

Applicants request the Director to review the Examiner's restriction requirement issued in this case. No fee is believed to be due with the filing of this petition. If a fee is deemed due, Applicants authorize the director to debit deposit account number 07-0893 for that amount.

FACTS:

In his June 18, 2007 office action the Examiner issued a four way restriction requirement. The Examiner indicated that the Applicants must choose one grouping of claims to be Examined from the following groupings:

- (I) Claims 1 to 22;
- (II) Claim 23;
- (III) Claims 24 to 68; or
- (IV) Claim 69.

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Applicants chose grouping III (claims 24 to 68) with traverse and asked the Examiner to reconsider and withdraw the restriction requirement as it was made in error. *See* Applicants' July 17, 2007 response. In his September 25, 2007 office action the Examiner indicated that he reconsidered and maintained the restriction requirement as issued. This petition follows. Applicants request the Director to review and reverse the restriction requirement made in this case.

THE EXAMINER'S RESTRICTION REQUIREMENT IS MADE IN ERROR AND MUST BE WITHDRAWN:

Applicants have elected claim grouping III (claims 24 to 68) with traverse. Applicants submit that claim group IV is a species of the generic claims of group III and therefore, that group IV must be examined with group III. Furthermore, Applicants submit that the Examiner has failed to demonstrate that any of the claim groupings are (1) separate and distinct inventions, and (2) that undue burden will result on the Examiner if all claims remain in the present application. Therefore, Applicants submit the restriction requirement should be withdrawn in its entirety.

Claim group IV is a species of claim group III and they must be examined together:

Claim group IV (claim 69) is a species of the claims of elected group III expressed as an independent article claim. Claim 69 is similar to article claim 47 and comprises limitations from dependent claims 48 to 68 (as demonstrated below) and therefore should not be considered separate and distinct from the claims in group III.

Claim 69 reads:

A storage medium for data comprising a polycarbonate wherein the polycarbonate comprises a perylene wherein the perylene has a temperature stability of at least

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about 350 ° C, is present in a range between about 10^{-18} percent by weight and about 2 percent by weight of the total polycarbonate, and is detectable via a spectrofluorometer at an excitation wavelength in a range between about 100 nanometers and about 1100 nanometers.

Independent claim 47 of elected group III is directed to articles made from a polymer containing a tagging material that *has a temperature stability of at least about 350 ° C and is detectable via a spectrofluorometer at an excitation wavelength in a range between about 100 nanometers and about 1100 nanometers*. Dependent claim 52 (of group III), specifies that the tagging material includes a *perylene*. Dependent claim 62 (of group III) specifies that the polymer comprises *polycarbonate*. A *storage medium* is an article formed from a polymeric material as reflected in claim 64 (of group III). **Claim 69 is merely a species within the scope of the claims of group III and is not separate and distinct.** Thus the restriction between claim groups III and IV is incorrect and must be withdrawn.

The Examiner's basis for maintaining the restriction is incorrect and the restriction requirement must be withdrawn in its entirety:

The Examiner has presented as the basis for maintaining the restriction requirement the form paragraphs which relate to claims directed to **subcombinations and combinations**. However, **none of the groups outlined by the Examiner are so related**, and therefore the basis

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for maintaining the restriction requirement is in error.¹

The Examiner has not correctly established different classifications for the claims, and thus has not established (1) that the claims relate to separate and distinct inventions and (2) that undue burden would arise if these claims are to remain in the present application. Furthermore, as demonstrated below, all claims of the present application are related in that they contain similar limitations such that a search of the method claims would return results for the composition claims and *vice versa*. Thus, there is no undue burden by maintaining the claims in the present application. Accordingly, Applicants submit that all of the claims should be considered in a single application and request withdrawal of the restriction requirement in its entirety.

Claim group I (claims 1 to 22) is drawn to a method of identifying a polymer using a tagging material. **Claim Group II** (claim 23) is a species of generic claim 1 expressed as an independent method claim similar to claim 1 comprising limitations of dependent claims 2 to 22, as demonstrated below, and therefore should not be separated from the claims of group I.²

Claim 23 reads:

A method for identifying a polycarbonate, comprising providing in the polycarbonate at least one tagging material wherein the tagging material comprises a perylene, wherein the perylene has a temperature stability of at least about 350 °C, is present in a range between about 10⁻¹⁸ percent by weight and about 2 percent by weight of the total polycarbonate and is detectible via a spectrofluorometer at an excitation wavelength in a range between

¹ Applicants note that the claim groupings are related as compositions (Group III and IV) and methods of using these compositions (Groups I and II).

² Claim group II is related to claim group I as claim group IV is related to claim group III.

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about 100 nanometers and about 1100 nanometers.

Independent claim 1 (of claim group I) is directed to a method for identifying a polymer (e.g. *polycarbonate* of claim 16) comprising providing in the polymer at least one tagging material comprising ... fluorophore (e.g. perylenes of claim 6) wherein the tagging material has a temperature stability of at least about 350 °C and is present in a sufficient quantity (between about 10⁻¹⁸ percent by weight and about 2 percent by weight) such that the tagging material is detectible via a spectrofluorometer at an excitation wavelength in a range between about 100 nanometers and about 1100 nanometers. **Thus, claim 23 is merely a species within the scope of the claims of Group I.** Accordingly, the restriction of claim group II from claim group I should be withdrawn.

Claim group III (claims 24 to 68) is a polymer (claim 24 to 46) containing a tagging material, or an article (claims 47 to 68) made from such a polymer. All of the limitations concerning the polymer and tagging material in independent claims 24 and 47 are the same as in claim 1, these materials and articles are related to the group I claims as product and method of making. Therefore, these claims should not be separated from claim group I.

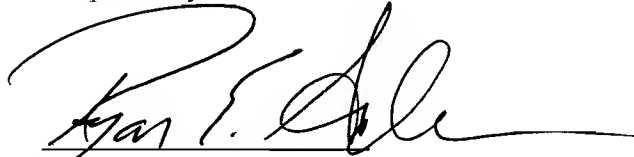
Claim group IV (claim 69) as demonstrated above is a species of claim group III. Therefore, claim 69 should not be separated from claim group III.

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CONCLUSION:

Applicants submit that all of the claims should be considered in a single application and request withdrawal of the restriction requirement in its entirety.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Marina T. Larson", with a long horizontal flourish extending to the right.

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